A

MCLAREN INTERNATIONAL LTD

v.

LIM YAT MEEN

B

FEDERAL COURT, PUTRAJAYA
RICHARD MALANJUM CJ (SABAH & SARAWAK)
ABDUL AZIZ MOHAMAD FCJ
HASHIM YUSOFF FCJ
[CIVIL APPEAL NO: 02(f)-2-2008]

C

8 JUNE 2009

TRADE MARKS: *Registered trade mark - Expungement - Whether party whose application for registration of a trade mark jeopardised under s. 19(1) Trade Marks Act 1976 qualifies as an "aggrieved person" -*

D

Whether question if appellant a person aggrieved outside scope of appeal - Locus standi - Trade Marks Act 1976, ss. 19(1), 45, 46

The appellant's application for an order expunging totally the entry of the respondent's trade mark from the Register of Trade Marks had failed in the High Court and the Court of Appeal. The appellant was subsequently granted leave to appeal to this court on the following two questions: (i) Whether a party whose application for registration of a trade mark is obstructed under s. 19 of the Trade Marks Act 1976 ('Act') by the prior registration of an identical or similar mark on the Register of Trade Marks is an "aggrieved person" with the appropriate *locus standi* within the meaning of that term in ss. 45 and 46 of the Act; and (ii) whether in the face of uncontroverted evidence of non-use of a registered mark in relation to some only of the registered goods, such goods may be rectified by their removal or expunged pursuant to the entitlements in law under ss. 45 and 46 of the Act.

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Held (dismissing the appeal)
Per Abdul Aziz Mohamad FCJ delivering the judgment of the court:

H

(1) Question (i) could not be answered in the affirmative. A person whose application for registration of his trade mark is jeopardised by s. 19(1) of the Act cannot, without more, qualify as a person aggrieved, because he could be a mere busybody. *Fazaruddin Ibrahim v. Parkson Corp Sdn Bhd* (ovrd); *Re Arnold D Palmer* (foll). (para 20)

I

(2) The question whether, on the facts, the appellant passed the test of a person aggrieved as laid down in *Re Arnold D Palmer* was outside the scope of this appeal. It was a question of fact and, contrary to the appellant's claim, some of the facts were, moreover, judging by the respondent's affidavit-in-reply, hotly in dispute. To top it all, there was no leave-question to cater for the appellant's alternative stand. The only leave-question on which the appellant could rely for a finding that it was an "aggrieved person" was Question (i), if answered in the affirmative; this court had already opined that it could not. As the appellant failed in this appeal on the question of *locus standi*, this appeal ought to be dismissed without any need to answer Question (ii), which went to the merits of the appellant's application. (paras 24 & 25)

Bahasa Malaysia *Translation Of Headnotes*

Permohonan perayu untuk mendapat satu perintah memadamkan dengan sepenuhnya pemasukkan cap dagang responden daripada Daftar Cap Dagang telah gagal dalam Mahkamah Tinggi dan Mahkamah Rayuan. Perayu kemudiannya diberi kebenaran untuk merayu ke mahkamah ini atas dua soalan-soalan yang berikut: (i) Sama ada sesuatu pihak yang permohonannya untuk pendaftaran suatu cap dagang telah dihalang di bawah s. 19 Akta Cap Dagang 1976 ('Akta') oleh satu pendaftaran sebelumnya suatu cap yang sama atau serupa atas Daftar Cap Dagang ialah "orang terkilan" dengan *locus standi* yang berpatutan seperti yang dimaksudkan oleh terma itu dalam ss. 45 dan 46 Akta; dan (ii) sama ada bila berhadapan dengan keterangan yang tidak boleh disangkal ketidakgunaan suatu cap berdaftar berhubungan dengan hanya sedikit daripada barang-barang berdaftar, barang-barang sebegitu boleh dibetulkan dengan pembuangan atau pemadamannya mengikut hak-hak undang-undang di bawah ss. 45 dan 46 Akta.

Diputuskan (menolak rayuan)
Oleh Abdul Aziz Mohamad HMP menyampaikan penghakiman mahkamah:

(1) Soalan (i) tidak boleh dijawab secara afirmatif. Seorang yang permohonannya untuk mendaftarkan cap dagangnya digugat oleh s. 19(1) Akta tidak boleh, tanpa lebih, layak sebagai orang terkilan, kerana beliau boleh jadi hanya seorang yang mencampuri urusan orang lain. *Fazaruddin Ibrahim v. Parkson Corp Sdn Bhd* (ditolak); *Re Arnold D Palmer* (diikuti).

(2) Soalan sama ada, atas fakta-fakta, perayu melepasi ujian seorang terkilan seperti yang dinyatakan dalam *Re Arnold D Palmer* terletak di luar skop rayuan semasa. Ia adalah soalan fakta dan, bertentangan dengan tuntutan perayu, beberapa fakta-fakta, tambahan pula, memandangkan afidavit jawapan responden, sedang dipertikaikan dengan hangat. Tambahan lagi, tidak ada soalan-kebenaran untuk memenuhi pendirian alternatif perayu. Soalan-kebenaran yang sulung atas mana perayu boleh berharap untuk memperolehi dapatan bahawa ia "orang terkilan" ialah Soalan (i), jikalau dijawab dengan afirmatif; mahkamah ini telahpun berpendapat bahawa ia tidak boleh. Oleh kerana perayu telah gagal dalam rayuan semasa atas soalan *locus standi*, rayuan semasa sepatutnya ditolak tanpa perlunya menjawab Soalan (ii), yang berkaitan dengan merit-merit permohonan perayu.

Case(s) referred to:

Consort Trade Mark [1980] RPC 160 ***(refd)***

Fazaruddin Ibrahim v. Parkson Corporation Sdn Bhd [1997] 2 CLJ 863 HC ***(ovrd)***

Lever Bros, Port Sunlight Ltd v. Sunniwite Products Ltd [1949] 66 RPC 84 ***(refd)***

McLaren International Ltd v. Lim Yat Meen [2008] 1 CLJ 613 CA ***(refd)***

Powell's Trade Mark [1894] 11 RPC 4 ***(refd)***

Re Arnold D Palmer [1987] 2 MLJ 681 ***(foll)***

Service Master (M) Sdn Bhd v. MHL ServiceMaster Sdn Bhd & Anor [1998] 1 CLJ 459 HC ***(refd)***

Wells Fargo Trade Mark [1977] RPC 503 ***(refd)***

Legislation referred to:

Trade Marks Act 1976, ss. 14, 19(1), 25, 37, 45(1)(a), 46(1), 48(1), (2)

For the appellants - SF Wong (S Indran with him); M/s Shearn Delamore & Co

For the respondent - Suaran Singh; M/s Sekhar & Suaran

[Appeal from Court of Appeal, Civil Appeal No: W-02-205-2005]

[Editor's note: For the Court of Appeal judgment, please see McLaren International Ltd v. Lim Yat Meen [2008] 1 CLJ 613.]

Reported by Suresh Nathan

JUDGMENT

Abdul Aziz Mohamad FCJ:

[1] The respondent has been the registered proprietor of the trade mark "McLaren" (Trade Mark No. 9202266) since 11 April 1992, when he applied for registration of the trade mark. The approval of the registration had retrospective effect from that date. The registration is in respect of "articles of clothing, including boots, shoes and slippers" in Class 25.

[2] Over seven years later, on 11 August 1999, the appellant company, claiming to be the *bona fide* proprietor of the trade mark "McLaren", filed application No. 9907641 for registration of the trade mark in respect of "articles of clothing, footwear and headgear" in Class 25.

[3] On 16 February 2001, the Registrar of Trade Marks informed the appellants that their application contravened s. 19(1) of the Trade Marks Act 1976 ("the Act") in that the trade mark whose registration the appellants sought was identical with the respondent's registered trade mark or so nearly resembled the respondent's registered trade mark as was likely to deceive or cause confusion. Section 19(1) prohibits the registration of such a trade mark in respect of any goods or description of goods.

[4] On 3 March 2003, the appellants, by notice of originating motion, applied for an order expunging totally the entry of the respondent's Trade Mark No. 9202266 from the Register of Trade Marks. For this relief the appellants cited ss. 14, 25, 45 and 46(1) of the Act. Alternatively, relying on s. 46(1) only, the appellants sought an order varying the entry by the deletion of the words "articles of clothing, including" from the description of the goods to which the respondent's trade mark relates.

[5] It is useful to state what the sections on which the appellants' application relied are about. By s. 45 the High Court, on the application of any "person aggrieved" by, *inter alia*, "any entry made in the register without sufficient cause or ... any entry wrongfully remaining in the register", is empowered to "make such order for ... expunging or varying such entry as it thinks fit". This is provided in para (a) of s. 45(1). It is about expunging or varying an entry that is shown, after the entry was made, to be an entry that, for some reason or other, was a wrongful entry.

[6] Section 46(1) provides as follows:

> (1) Subject to this section and to section 57, the Court may, on application by a person aggrieved, order a trade mark to be removed from the Register in respect of any of the goods or services in respect of which it is registered on the ground:
>
> (a) that the trade mark was registered without an intention in good faith, on the part of the applicant for registration or, if it was registered under subsection (1) of section 26, on the part of the body corporate or registered user concerned, to use the trade mark in relation to those goods or services and that there has in fact been no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being up to the date one month before the date of the application; or
>
> (b) that up to one month before the date of the application a continuous period of not less than three years had elapsed during which the trade mark was a registered trade mark and during which there was no use in good faith of the trade mark in relation to those goods or services by the registered proprietor or registered user of the trade mark for the time being.

It empowers the court, that is the High Court, on the application of a "person aggrieved" to order a trade mark to be removed from the register for reason of non-use. The grounds in paras (a) and (b) are independent alternative grounds that are not related to one another.

[7] The essential difference between s. 45(1)(a) and s. 46(1) is that in an application under s. 45(1)(a) some legally-recognized fault has to be shown to have been made in respect of the entry whereas in an application under s. 46(1) no such fault has to be shown. What has to be shown is non-use of a trade mark that may have been properly and faultlessly registered.

[8] Section 14 prohibits the registration of a mark or part of a mark as a trade mark in several circumstances, one of which is "if the use of [it] is likely to deceive or cause confusion to the public". It is relevant to an application under s. 45(1)(a) because if a mark has been registered in contravention of s. 14, it may be

argued, for an application under s. 45(1)(a), that the entry was made without sufficient cause or that it is an entry wrongfully remaining in the register.

[9] Section 25 is about the procedure for the registration of a trade mark. By its subsection (1), an applicant for the registration of a trade mark must be a person claiming to be its proprietor. Since the appellants claimed that the respondent was not the lawful proprietor of the trade mark "McLaren" and therefore his application of 11 April 1992 did not deserve to be allowed, the appellants must have relied on s. 25 as also relevant to s. 45(1)(a).

[10] Essentially, therefore, the appellants' application was under ss. 45(1)(a) and 46(1). To succeed under either provision, they had to show that they were a person aggrieved and that they had a case under either section; that is to say, they had both to establish *locus standi* and to show merit.

[11] The appellants failed in the High Court and the Court of Appeal. At the High Court the learned judge found that the appellants were not a person aggrieved but it seems to us, from the way the judgment is written, that that finding as to the appellants' *locus standi* was made upon a finding that the appellants failed to make out a case on the merits. As to the merits, the matters that the learned judge found were mostly relevant to s. 45(1)(a), including the finding that s. 37 applied to render the registration of the respondent's trade mark conclusive after seven years. And it should be mentioned that the respondent's counsel did admit to us that s. 37 was urged only in relation to s. 45(1)(a) and not in relation to s. 46(1). The learned judge's findings that were relevant to s. 46(1) were only the finding that the trade mark was used by the respondent on men's executive shoes – a finding made on the basis of sales of the shoes by Stonefly Enterprise and United Summary Sdn Bhd – and that it was not necessary for those two entities to be registered as registered users under s. 48. That section, to the extent only of subsections (1) and (2), provides as follows:

> 48(1) Subject to the provisions of this section, where the registered proprietor of a trade mark grants, by lawful contract, a right to any person to use the trade mark for all or any of the goods or services in respect of which the trade mark is registered, that person may be entered on the Register as a

registered user of the said trade mark whether with or without any conditions or restrictions, provided that it shall be a condition of any such registration that the registered proprietor shall retain and exercise control over the use of the trade mark and over the quality of the goods or services provided by the registered user in connection with that trade mark.

(2) Where it is proposed that a person shall be registered as a registered user of a trade mark, the registered proprietor shall submit an application to the Registrar for the registration of that person as a registered user of the trade mark and such application shall be accompanied by the prescribed fee and the following information:

(a) the representation of the registered trade mark;

(b) the names, addresses, and addresses for service of the parties;

(c) the goods or services in respect of which the registration is proposed;

(d) any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use or to any other matter; and

(e) whether the permitted use is to be for a period or without limit of period, and if for a period, the duration of that period.

[12] The learned judge made no mention of the appellants' alternative prayer.

[13] The Court of Appeal's judgment is reported as *McLaren International Ltd v. Lim Yat Meen* [2008] 1 CLJ 613. In paras [11], [12] and [13], the Court of Appeal mentioned three cases on when a person can be said to be a "person aggrieved" for the purposes of ss. 45(1)(a) and 46(1). The first is *Fazaruddin bin Ibrahim v. Parkson Corporation Sdn Bhd* [1997] 2 CLJ 863, but we will refer to the report in [1977] 4 MLJ 360. In that case Abdul Malik Ishak J said, at p. 369: "The phrase 'person aggrieved' in s. 45(1)(a) of the Act should be construed liberally. In my judgment, it includes any person whose own application for registration is obstructed by the opposing party in the suit ..." The second is *Service Master (M) Sdn Bhd v. MHL ServiceMaster Sdn*

Bhd & Anor [1998] 1 CLJ 459, a decision of Kamalanathan Ratnam JC which the Court of Appeal saw as being in conflict with the approach in *Fazaruddin*. The third is a Singapore case of a date earlier than the other two, *Re Arnold D. Palmer* [1987] 2 MLJ 681, from which the Court of Appeal quoted the following words of Chan Sek Keong JC: "... it cannot be right, in principle, that the mere filing of his application can confer the necessary *locus standi* on the applicant for the purpose of rectifying proceedings".

[14] After touching on those three cases the Court of Appeal proceeded to what appears to us to be a consideration of the merits of the appellants' application under s. 45(1)(a), in the course of which the Court of Appeal made what amounted to a finding that there was no fault in the registration of the respondent's trade mark and referred to the protection of s. 37 in favour of the respondent, and then came to the following conclusion in para [21]:

> [21] From the above prognosis, surely the best approach to arrive at a correct decision whether an applicant is an aggrieved person is by bringing all the available evidence to bear before the judge, rather than debating whether the terminology of "an aggrieved person" should be given a wide or restricted interpretation. By this method, irrespective of the scope of the two words, the learned judge will be able to arrive at a more meaningful decision. Despite the valiant attempt by the appellant, regretfully after having weighed all the agreed facts and evidence, we decided that it did not qualify as an aggrieved person and hence had no locus standi to initiate the action, be it pursuant to ss. 45 or 46 of the Trade Marks Act 1976.

[15] It appears to us that the Court of Appeal was influenced by the lack of merit in the appellants' case under s. 45(1)(a) to arrive at the conclusion that they were not an aggrieved person.

[16] The only manner in which the Court of Appeal dealt with the appellants' application under s. 46(1) was by making a finding in para [28] that s. 48 did not make it mandatory for Stonefly Enterprise and United Summary Sdn Bhd to be registered as registered users.

[17] The Court of Appeal made no mention of the appellants' alternative prayer.

[18] Leave was granted to the appellants to appeal to this court on the following two questions:

(a) Is a party whose application for registration of a trade mark obstructed under section 19 of the Trade Marks Act 1976 by the prior registration of an identical or similar mark on the Register of Trademarks an "aggrieved person" with the appropriate locus standi within the meaning of that term in sections 45 and 46 of the Trade Marks Act 1976.

(b) Whether in the face of uncontroverted evidence of non use of a registered mark in relation to some only of the registered goods, such only of the goods may be rectified by their removal or expunged pursuant the entitlements in law under sections 45 and 46 of the Trade Marks Act 1976.

The appellants have decided not to rely on their application under s. 45. Therefore the references to that section in the two questions are to be disregarded. The appellants rely only on their application under s. 46(1), and they rely only on para (b) of the section. Paragraph (a) is therefore not involved in this appeal. Only para (b) is involved in this appeal.

Question (a)

[19] It goes without saying that the appellants' purpose behind Question (a) is to get this court to answer, contrary to the Court of Appeal's finding, that the appellants were a person aggrieved. But the appellants' counsel did not place his hopes entirely on an answer to Question (a) in the affirmative. While contending, in reliance on what Abdul Malik Ishak J said in *Fazaruddin*, that the appellants should be accepted as a person aggrieved by reason solely that their application for registration of the "McLaren" trade mark encountered, on 16 February 2001, the obstruction of s. 19(1), and while urging this court, "in the national interest", to endorse the "liberal approach" in *Fazaruddin*, the appellants' counsel also submitted that on the facts the appellants qualified as a person aggrieved according to the test in *Re Arnold D. Palmer*. It was rather on those facts that the appellants themselves in their affidavit claimed to be a person aggrieved and not on the mere fact of their application being obstructed under s. 19(1).

[20] Indeed, in our judgment, Question (a) cannot be answered in the affirmative. A person whose application for registration of his trade mark is jeopardized by s. 19(1) cannot, without more, qualify as a person aggrieved, because he could be a mere busybody. An answer in the affirmative that the appellants want to Question (a) would uphold Abdul Malik Ishak J's statement in *Fazaruddin*, which was made without any supporting authority. The proposal in the statement had been rejected ten years before in *Re Arnold D. Palmer*, in the following passage at p. 686 which contains the words that the Court of Appeal cited:

> ... The registration of a trade mark in the name of a proprietor, once effected, ought not to be disturbed by persons who have no trading interest in the goods concerned. If an applicant for rectification has no such interest to begin with, and therefore cannot suffer any damage at all by the existence of a conflicting trade mark on the register, it cannot be right, in principle, that the mere filing of his application can confer the necessary *locus standi* on the applicant for the purpose of rectifying proceedings. Otherwise, the test of grievance propounded in *Powell's Trade Mark* [1984] 11 RPC 7; [1984] AC 8 would be completely nullified by resorting to the simple expediency of applying to register the very mark the applicant seeks to expunge ...

[21] *Re Arnold D. Palmer* is an authority (out of several) that is heavily relied on by the respondent to deny that the appellants are a person aggrieved. In that case the applicant sought the removal from the register of a trade mark on the ground of non-user. On whether the applicant was a person aggrieved, Chan Sek Keong JC, after considering the speeches of Lord Herschell and Lord Watson in the House of Lords in *Powell's Trade Mark* [1894] 11 RPC 4; [1984] AC 8, and the manner in which subsequent judges reacted to the opinions of the said Law Lords in *Lever Bros. v Sunniwite Products* [1949] 66 RPC 84, *Consort Trade Mark* [1980] RPC 160, and *Wells Fargo Trade Mark* [1977] RPC 503, concluded as follows:

> On the basis of these decisions, it is plain that the applicant will fail in this appeal unless he can show that he has used his trade mark in the course of a trade which is the same as or similar to that of the respondents or that he has a genuine and present intention to use the mark as a trade mark. But the evidence shows none of these things, as the Registrar has found. ...

[22] We understand that passage as laying down the principle that a person aggrieved is a person who has used his mark as a trade mark – or who has a genuine and present intention to use his mark as a trade mark – in the course of a trade which is the same as or similar to the trade of the owner of the registered trade mark that the person wants to have removed from the register.

[23] The appellants' counsel submitted that on the facts adduced in the affidavit in support of the appellants' notice of originating motion, which facts counsel said were undisputed, the appellants satisfied the above test of a person aggrieved as expounded in *Re Arnold D. Palmer*. The facts, in the words of the appellants' company secretary who made the affidavit, are as follows:

> The Applicant is a company organised and existing under the laws of England ... The Applicant is the proprietor of the mark "McLaren" and has filed for a trade mark application under no. 99/07641 on 11th August 1999 in relation to "articles of clothing, footwear and headgear." The mark "McLaren" has long been associated with the Formula 1 race of which the McLaren team is well-known worldwide, including Malaysia. I verily believe that the "McLaren" mark is known to the Malaysian public long before the Sepang F1 circuit was established by virtue of the various sports programmes and telecast of the races on Malaysian television. The McLaren team has been participating in the Formula 1 race for 37 years and I verily believe that there are many supporters of the McLaren team in Malaysia. (Broadcasting statistics for 1993-2000 are exhibited) ... Pursuant to the popularity of the McLaren team, merchandise bearing the "McLaren" mark have been offered for sale by the Applicants for over 10 years. Customers buying the products will immediately identify and associate such merchandise with the Applicants and equate the same with products endorsed by the McLaren team. (A recent catalogue of merchandise offered under the "McLaren" mark is exhibited). These products are made available by mail order to any person anywhere in the world. There is also a membership programme for Team McLaren which is open to anyone from around the world. Membership benefits include discounted prices on McLaren merchandise and free subscription to the McLaren magazines. (A copy of the McLaren magazine entitled "Racing Line" is exhibited). The "McLaren" mark has also been extensively promoted both internationally and in Malaysia. Other than in "Racing Line" magazine, promotion of

> the "McLaren" mark is conducted *via* the website www.mclaren.com as well as on-site promotion such as at the Sepang F1 circuit. The "McLaren" mark is also promoted *via* the website of the Sepang F1 circuit, http://www.f1-malaysia.com. (Printouts from those websites are exhibited). By virtue of the foregoing, I verily believe that the "McLaren" mark is well-known in Malaysia and the Applicant enjoys considerable reputation and goodwill amongst the Malaysian public in respect of the "McLaren" mark not only as the Formula 1 team but also for the merchandise associated therewith, particularly, clothing. ... The Applicant's trade mark application has been objected to by the Registrar of Trade Marks on the basis of the Respondent's said mark. As both marks are similar, the Applicant's application will not be able to proceed to registration in light of the earlier registration by the Respondent unless the said trade mark registration is expunged. By virtue of the Applicant's reputation and goodwill subsisting in the "McLaren" mark, and use thereof in Malaysia, the Respondent's continued registration of the said mark will seriously jeopardize the Applicant's right and interests in the exploitation of its "McLaren" mark. I verily believe and am advised by the Applicant's solicitors that the Applicant is therefore aggrieved by the registration of the said mark by the Respondent and has *locus standi* to apply to the Honourable Court to rectify the Register.

[24] In our judgment the question whether, on the facts, the appellants pass the test of a person aggrieved as laid down in *Re Arnold D. Palmer* is outside the scope of this appeal. It is a question of fact, and, contrary to the claim of the appellants' counsel, some of the facts are, moreover, judging by the respondent's affidavit in reply, hotly in dispute. To top it all, there is no leave-question to cater for the appellants' alternative stand. The only leave-question on which the appellants can rely for a finding that they are an aggrieved person is Question (a), if answered in the affirmative. We have already opined that it cannot be answered in the affirmative.

[25] As the appellants fail in this appeal on the question of *locus standi*, this appeal ought to be dismissed without any need to answer Question (b), which is the question as to the merits of the appellants' application. We will nonetheless deal with that question.

A **Question (b)**

[26] As we said, in this appeal the appellants rely only on para (b) of s. 46(1). According to s. 46(1)(b), applying it to the present case, the court may order the respondent's "McLaren" trade mark
B to be removed from the register in respect of any of the following goods, namely, articles of clothing, boots, shoes and slippers, if, for a certain period, there was no use in good faith of that trade mark in relation to those goods by the respondent (as the registered proprietor of the trade mark) or by the registered user
C of the trade mark. The period is a continuous period of three years until 3 February 2003, which was one month before the date of the appellants' application, 3 March 2003. In other words, the period is a continuous period of non-use from 3 February 2000 until 3 February 2003.

D

[27] It is an admitted fact that the respondent's trade mark, since it was registered on 11 April 1992, had been used only in respect of executive men's shoes. The respondent claimed in paras 5 and 6 of his affidavit dated 23 November 2004: "... all the men's
E executive shoes bearing the mark MCLAREN that were contract-manufactured by Stonefly Enterprise and United Summary Sdn Bhd were done pursuant to the ongoing contractual relationships between me and Stonefly Enterprise and United Summary Sdn Bhd respectively. Both (those entities) were acting as my agents
F to use the mark MCLAREN for the purpose of dealing with men's executive shoes bearing the MCLAREN trade mark in Kelantan since May 1999 and in Kuala Lumpur since early 2000".

[28] There are two facets to the application of s. 46(1)(b) to the facts of this case. The first facet concerns the fact that in any
G event, let alone during the said period of three years, there was no use of the respondent's registered trade mark in relation to some of the goods in respect of which the trade mark is registered, that is to say, in relation to articles of clothing other than footwear. The court is therefore empowered to order the
H respondent's trade mark to be removed from the register in respect of such articles of clothing, or, in other words, to grant the appellants' alternative prayer for an order of deletion of the words "articles of clothing, including" from the description of the goods to which the respondent's trade mark relates. The
I respondent's only answer to the alternative prayer, which does

not avail with us, is to ask the court, in exercising its discretionary power under s. 46(1)(b), to take into consideration matters "such as questions of good faith and public interest", as the respondent, so he claims, had the necessary intention to use the trade mark in relation to all the goods in respect of which it is registered.

[29] The second facet concerns the fact that during the relevant three years the respondent's trade mark was used in relation to executive men's shoes, which constitute some of the goods in respect of which the trade mark is registered. So that the ground for removal of the trade mark under s. 46(1)(b) in respect of those goods may be avoided or prevented from arising, the use must be use by the respondent himself as the registered proprietor or by the registered user of the trade mark, besides the use having to be in good faith. A registered user is a person registered as such under s. 48. Stonefly and United Summary were never registered under s. 48 as registered users of the respondent's trade mark. Although, as the Court of Appeal said, s. 48 did not make it mandatory for them to be registered as such, their not being so registered has the consequence that for the purposes of s. 46(1)(b) the use of the respondent's trade mark by them was not use by a registered user. That leaves the question whether the use of the trade mark on executive men's shoes by those entities was use as agent for the respondent and therefore was use by the respondent as the registered proprietor. That was one of the arguments of the respondent in the High Court, against which the appellants presented strong arguments in submission, and in the present appeal we do not see the respondent repeating the argument at all or with any degree of enthusiasm.

[30] But Question (b) is not concerned with the second facet. It is concerned only with the first facet. It is predicated on "uncontroverted evidence of non use of a registered mark in relation to some only of the registered goods", which can only be non-use in relation to articles of clothing other than footwear. Question (b) is clearly a question that is looking at the appellants' alternative prayer. An affirmative answer to Question (b), which is the answer that the appellants want, can only sensibly and logically result in the granting of the alternative prayer. Therefore, were the appellants to succeed in this appeal on the question of locus standi, we would allow the appeal but only to the extent of

granting the alternative prayer. But since the appellants fail on the question of *locus standi*, we dismiss the appeal with costs and order that the deposit be paid to the respondent to account of his taxed costs.